

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims supersedes any previous listing. Favorable reexamination and reconsideration is respectfully requested in view of the preceding amendments and the following remarks.

Declaration

A Declaration by the inventor averring to aspects of the claimed subject matter is submitted herewith. This document evidences the claimed infection of the grass and the grass seeds.

Rejections under 35 USC § 101

The rejection based on the position the claims read on plants that are found in nature is traversed. The claims cannot read on grass that this found in nature because it is required to be infected with a fungus which is "artificially" introduced thereinto. The claim language has been changed to call for the symbiotic fungus to be artificially and permanently introduced into said grass. The term "into" must be seen as differentiating over a fungus "on" the grass and therefore positioned so that it is exposed to the elements and so that it may be "washed off by the next rain" as suggested in the rejection.

As to claims 5 and 6, it is submitted that the Declaration which is submitted with this response makes it clear that the claimed subject matter is such as to provide assurance that a plant grown from an effected seed will be infected and that seeds in grass infected with the claimed fungus are also infected.

It is submitted that the artificial introduction of the claimed fungus into a naturally occurring grass would change it and differentiate it over other naturally occurring grass which does not have the fungus artificially introduced thereinto.

Rejections under 35 USC § 112

In connection with the artificial introduction, claim 4 does not specify the site or mode of "introduction" or the amount introduced. In other words, the Examiner is of the opinion that the claims do not explain how the infection is carried out.

In rebuttal, it is pointed out that claims are intended to claim and the specification is intended to explain. In the 1985 decision of SRI International v. Matsushita Electric Corp., the court clearly expressed "Specifications teach. Claims claim."

Further, the specification is not required to disclose in minute detail processes that are within the purview of a person skilled in the related art or an art which is most closely related thereto. "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc v. Coherent, Inc., 827 F.2d 1524, 3 USPQ 1737 (Fed. Cir. 1987)." M.P.E.P. § 2164.01. Fungii are very adept at infecting hosts and special techniques and amounts are not normally required. Athlete's foot is one good example.

As to the confusion with "a final metabolic product" in claim 4, the Examiner's suggestion to use "the" in place of "a" has been adopted. It is assumed from the suggestion that the Examiner is not, in this instance, concerned with antecedent basis issues.

The amendments to claims 6 and 7 are deemed to overcome the issues raised on page 3 of this Office Action.

Rejections under 35 USC § 102

The claims as amended are not cast in product-by-process format in any shape fashion or form. Therefore, the anticipation rejections, which are clearly dependent on the claims being product-by-process in nature, are traversed.

Indeed, the Examiner's position that the expression "into which a symbiotic fungus is artificially introduced" renders the claims product-by-process is dashed by the amendments implemented *supra*. What is now claimed is basically a grass comprising a particular fungus. This is no more product by process than "an automotive vehicle comprising an engine", "a computer comprising a display", "a typewriter comprising keys", "a knife having a handle", etc.

Claim 4 is directed to a glass with fungus to produce chanoclavine as the final metabolic product. None of Porter et al. and Cagas et al., which are applied under § 102(b), disclose this.

That is to say, while Porter et al. and Cagas et al. disclose chanoclavine, none are such as to disclose or suggest that chanoclavine is the final metabolic product. For example, Cagas at Table 1 (P366) and Table 2 (P367) shows that chanoclavine is generated, but goes on to demonstrate that ergovaline is subsequently metabolized. As disclosed in paragraph [0016] of the instant specification, this is a toxic alkaloid that is avoided with the claimed invention. In the above mentioned art, chanoclavine is

an intermediate product which is consumed in the metabolism of ergopeptine which becomes the final product.

Thus, it is clear that the products of the references which are relied upon for rejection, contain toxic alkaloid type material and that the final metabolic product which is produced is not chanoclavine *per se*. For this reason, the references can not be relied upon to anticipate chanoclavine as a final metabolic product.

Conclusion

It is respectfully submitted that the claims as they have been amended are allowable over the cited references which have been applied in this Office Action. Favorable reconsideration and allowance of this application are courteously solicited.

If any further correction to the claims is required, please contact the undersigned agent.

IDS has been filed. A credit card authorization form in the amount of \$180.00 is attached herewith for filing IDS.

Respectfully submitted,

  
Manabu Kanesaka  
Registration No. 31,467  
Agent for Applicants

1700 Diagonal Road, Suite 310  
Alexandria, Virginia 22314  
(703) 519-9785